REMARKS

Rejections Under § 112

The Examiner rejected Claims 8, 20-28, 31-39 and 42 under § 112, first paragraph. The Examiner believed that the public place in Claims 20, 35 and 36 is not disclosed. The "public place" is no longer recited in the pending claims, thereby obviating the rejection. Claim 35 has now been amended to refer to a place where there are a plurality of television sets, which is disclosed in Paragraph [0039] of the published patent application. The Examiner also indicated that the stereo or video player of Claims 8 and 34 was inconsistent with the amendment to Claim 1 in which the device was specified to be a television. Claims 8 and 34 have been canceled so as to obviate this rejection.

In view of the amendments, withdrawal of the rejections under § 112 is respectfully requested.

Rejections under § 103

The rejections set forth by the Examiner in Paragraphs 7 through 12 and 18 of the Office Action all relate to claims that have been canceled. As such, these rejections are now moot. Accordingly, only the rejections set forth in Paragraphs 13 through 17 will be addressed below. Each of these rejections rests on a combination of Enomoto, Rumbolt, and Mullaly together with various other references. However, as explained below, the various combinations of references fail to suggest the claimed invention.

It is important to note that the method of the claimed invention is carried out "without selecting a set of encoded signals for the universal remote device." The prior art methods all designed to specifically select the encoded signals for the universal remote device or to select for a small number of devices to be effected. Thus, none of the references select the emission of twenty or more signals without selecting the set of signals specific to a limited number of devices. Since this limitation is nowhere suggested by any of the prior art references, no *prima facie* showing of obviousness can be established by the cited combinations of references.

The claimed method requires that a sufficient number of devices be controlled in order to carry out the purpose of being able to control a sufficient number of devices in an environment where the code of the device to be controlled cannot be known in advance. As explained in Paragraph [0002] of the specification as filed, a "particularly annoying problem occurs while trying to have a conversation in a location where a TV is powered on." Of course, the TV's and

other devices one encounters are manufactured by a great number of different companies who use a similar number of different power codes. The premise of this embodiment of the invention, as set forth in paragraph [0024] is that "it would be great to have a device that turns off any distracting TV that one comes across." In these circumstances, the signal required to turn off the television cannot be known prior to encountering it. Thus, the invention provides a universal remote control device that sequentially emits the signals for at least twenty televisions with a time period between signals of less than about ½ second. The inventor has discovered that if the signals for at least twenty different televisions are included, that a majority of television receiving devices can indeed be controlled.

In Paragraph 20 of the Office Action, the Examiner dismissed the criticality of the number of devices controlled because he believed this would have been obvious in view of Enomoto referring to Rumbolt, which includes a ROM having codes for most widely used appliances, and because a universal remote would need to include 20 codes. However, the universal control devices of Enomoto and Rumbolt are conventional universal remote control devices that are designed to be programmed to operate a particular device. These conventional universal remote control devices are described in Paragraph [0005] of the published specification of this application. After the programming step of the universal control devices of Enomoto and Rumbolt, these devices are configured to emit only a single signal that operates the device to which they are programmed.

Moreover, even the programming step of the conventional universal remote control devices of the type described by Enomoto and Rumbolt, is unlike the method of the present invention. In order to avoid confusion during the programming, more than ½ second between emitted signals would be required. The teaching of van Ee would have no impact on this disclosure because it would not suggest that conventional remote control devices could be programmed with such a short time period between signals. Thus, there would be no motivation to combine these teachings to produce the claimed invention.

In contrast to the conventional universal remote control devices, the method of the present invention is designed to release a plurality of encoded signals each time the device is used so that a television in which the code cannot be known in advance can be affected without prior programming of the device. Thus, both the number of signals released and the time period between signals are result-effective critical parameters. If the number of signals were too low,

the probability would be too low for affecting the television in which the required signal could not be known in advance. If the time period between signals were too long, the wait to affect that television might be unreasonably long. The problem of confusion during programming is not an issue with the method of the invention because the device does not require any further programming by the user.

While the specification does not state that the precise number twenty devices is a critical parameter, the specification does disclose in Paragraph [0025] that the number of devices to be controlled is maximized and original Claim 6 discloses that at least twenty different devices are controlled. Thus, one of ordinary skill in the art would recognize that being able to control at least twenty different devices having different signals would be a critical feature of Applicant's invention that supports the patentability of the claims. A device lacking this critical limitation would be unable to turn off a sufficient number of devices to allow the user to overcome the "annoying problem" referred to above in a sufficient number of locations.

Furthermore, the criticality of these features need not be disclosed in the specification in order to be used to support the patentability of the claimed invention. M.P.E.P. 716.02(f) specifically provides that:

> The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded.

Thus, the advantages of the claimed invention relating to these features must be considered in evaluating the patentability of the claims.

The Examiner also dismissed Applicant's evidence of commercial success. The Examiner did not believe that the evidence of commercial success was commensurate in scope with the claims. The Examiner based this belief on the device in the declaration having 117 codes and a timing between signals of 205 milliseconds. However, the commercial success of the product does not rest on the specific number of devices affected, nor on the specific timing between signals. Rather, the device is designed to turn off televisions when the signal for turning that television off cannot be known in advance. Twenty or more devices with a timing of ½ second or less between signals is sufficient to achieve this result. As long as the device sold met these critical parameters, no effect on the number of sales would be expected to occur. Thus,

there is no reason to dismiss the sales data as not commensurate in scope with the claimed invention.

The Examiner also indicated that no comparison to sales of other universal remote control devices was provided. However, this information is not relevant to the present invention. The present invention was designed to fulfill a specific niche of avoiding the annoyance of televisions encountered in situations where the signal required to effect a particular function cannot be known in advance. This device does not compete with other universal remote control devices designed to be programmed to affect a particular television. As such, the comparison between sales of these conventional universal remote control devices and the present invention is simply not relevant.

Finally, the Examiner also did not believe that a nexus was established between the commercial success reported in the declaration and the inventive features of the device. The Examiner indicated that lack of marketing alone does not make a clear nexus. The Examiner indicated that the newspaper and magazine articles amount to free advertisement that would increase sales in the absence of paid marketing. However, in the present situation, the magazine and newspaper articles reported directly on the feature of the invention that distinguishes it from conventional universal remote control devices. All of the articles indicated that the device could turn off televisions anywhere. Thus, far from being merely "free advertisement" for the device, the articles served to motivate the public to carry out the methods presently claimed for reasons directly related to the purpose of the invention. Thus, the nexus between the commercial success and the claimed method is actually quite firmly established by these articles.

Conclusion

In view of the foregoing, the various combinations of references would not suggest the presently claimed method in which the signals for at least twenty televisions are sequentially emitted with less than about ½ second between signals so as to effect a function on a television in which the required signal cannot be known in advance without pre-programming the device. The criticality of these parameters has been fully established. Moreover, the commercial success attributable to the claimed method further evidences the nonobviousness of the claimed invention.l

The present application is now believed to be fully in condition for allowance, and such action is earnestly solicited. However, should any impediments to allowance be identified, the

Examiner is respectfully invited to contact the undersigned attorney at the telephone number appearing below.

Please charge the required fee for a one-month extension of time, as well as any other additional fees, including any fees for additional extension of time, to Deposit Account No. 11-1410.

Respectfully submitted,

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